

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Scott Brenner et al.

Serial No.: 10/074,743

Filed: February 12, 2002

Group Art Unit: 2623

Examiner: Annan Q. Shang

For: SYSTEM AND METHOD FOR PROVIDING VIDEO PROGRAM  
INFORMATION OR VIDEO PROGRAM CONTENT TO A USER

Attorney Docket No.: ATTB 0107 PUS

**PRE-APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Pre-Appeal Brief is submitted to address what is believed to be a clearly erroneous rejection of independent claim 65. Independent claim 65 stands rejected in the alternative under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) as either being anticipated or obvious over U.S.P.N. 6,219,837 to Yeo.

Independent claim 65 relates to a method for providing a synopsis of a television program. The synopsis includes a summary of the television program missed prior to selecting the television program for viewing. The method is limited to generating the synopsis only upon request and only if the synopsis was requested after tuning to an in-progress program. The synopsis is not generated until it is requested, i.e., it is not transmitted with the television program.

In order to properly reject independent claim 65 under either 35 U.S.C. § 102(e) or 103(a), the Yeo patent must disclose or suggest generating the synopsis only upon request, which must be made after tuning to an in-progress television program. The Yeo patent fails to disclose or suggest the required limitations.

The Yeo patent embeds a number of summary frames within a television program broadcast. The embedded frames are automatically displayed when the program is selected. (See Figure 1 where the summary frames are referred to as reference numerals 20, 22 and 24 and the broadcast program is shown within the screen 18.) The summary frames depict key scenes from the past which aid the viewer in quickly ascertaining the current plot or theme. The summary frames are selected from the video embedded within the video prior to broadcasting. (Column 3, lines 20-30).

Figure 4 illustrates a process for embedding the summary frames where the summary frames are extracted from video signals 403 at step 404. Next, at step 405, the summary frames are embedded within the video signals to form a combined video signal that is transmitted through communication channels 402 to a settop box 413 for display on a television screen 412. (Column 4, lines 20-40). Because the Yeo patent selects the summary frames and embeds the selected frames with the television program broadcast, the Yeo patent fails to disclose generating the synopsis **only upon request**, let alone after tuning to an in-progress television program. The Yeo patent generates the summary frames regardless of whether they are requested or not.

Not only does the Yeo patent fail to disclose generating the synopsis upon request, the Yeo patent teaches away from doing so. As clearly pointed out in the Yeo patent, the summary frames are embedded within the television broadcast so that the summary frames are immediately available and catch the viewer's attention in a manner that aides in immediately understanding the program when a viewer tunes to a new channel. (Column 3, lines 49-53). In

order to suggest the present invention, the Yeo patent must be modified to instead delay packaging of the summary frames until receipt of a related request. A reference teaches away from a suggested modification when the modification is contrary to an advantage attendant to its principle of operation. The express advantage of immediately displaying the summary frames upon tuning to the television program, i.e., without being requested to do so, would be lost if the Yeo patent were so modified.

The Examiner's position appears to be that simply tuning to the television program is an act tantamount to the 'request' claimed by the present invention and therefore the Yeo patent does provide the summary frames upon request. This is not a fair or reasonable interpretation of the term "request". The claimed invention specifically claims 'generating' the synopsis upon request. This means the synopsis cannot be compiled, embedded, or otherwise prepared until requested. Even assuming, for the sake of argument, that the act of tuning to the television channel was a proper synopsis request, the Yeo patent still fails to generate, compile, embed, or otherwise prepare the summary frames upon request. The summary frames are generated prior to receiving the channel change request. Either way, the Yeo patent fails to suggest the claimed invention.

Because the Yeo patent fails to disclose or properly suggest the claimed invention, claim 65 is erroneously rejected under 35 U.S.C. § 102(e) and 103(a) over the Yeo patent. The remarks set forth above are limited to independent claim 65 in an effort to limit the issues presented for a Pre-Appeal conference. This is done without acquiescing or conceding the Examiner's position with respect to the remaining rejections. A Pre-Appeal Brief conference is respectfully requested to consider the remarks and to pass the case to issue.

Respectfully submitted,

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